

Appln. No. 10/04'',843
Amendment dated Mar. 30, 2005
Reply to Office Action of Nov. 30, 2004
Docket No. BOC9-1998-0053US2 (78-1)

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of November 30, 2004 (Office Action). This response is filed after the 3-month shortened statutory period along with a petition for an extension of time. The Examiner is authorized to charge the requisite fees for filing such a Request to Deposit Account No. 50-0951.

In paragraph 2 of the Office Action, the Examiner has provisionally rejected Claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,457,031 to Hanson, *et al* (Hanson). In response, since Hanson is commonly owned or subject to an assignment to the same entity as the present application, Applicants submit herewith an executed Terminal Disclaimer for the above-identified patent application to overcome the obviousness-type double patenting rejection. Withdrawal of the obviousness-type double patenting rejection with respect to claim 1 is respectfully requested.

In paragraph 3 of the Office Action, claims 1-7 and 10-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,857,099 to Mitchell, *et al*. (Mitchell) in view of U.S. Patent No. 6,113,394 to Edgar (Edgar) and in further view of U.S. Patent No. 6,195,637 to Ballard, *et al*. (Ballard). In paragraph 4, the Examiner has rejected claims 8, 9 and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Mitchell in view of Edgar and Ballard and in view of well known prior art.

With respect to the Examiner's rejection under 35 U.S.C. § 103(a), Applicant respectfully notes that at the time of the invention, Ballard was assigned to International

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Business Machines Corporation (IBM) of Armonk, New York. Accordingly, under 35 U.S.C. § 103(c), Ballard can not be used as a reference for rejection under 35 U.S.C. § 103(a) because it is subject matter that was co-owned or assigned to the same person as the present invention at the time the present invention was made. Consequently, the 35 U.S.C. § 103(a) rejections based upon Ballard, which includes claims 1-19 should be withdrawn, which action is respectfully requested.

Even though the Application should be in an allowable condition, Applicants shall take a brief moment to distinguish their invention over references of Mitchell and Edgar. The Applicants' claimed invention relates to a speech recognition system proofreader for performing deferred corrections upon post-dictated text without having to interrupt the playback of the proofreading process. More particularly, the Applicants teach that a dictation is to be text-to-speech converted. Then, the dictation is to be audibly played back, where the speech-to-text converted text is visually presented during playback, with the currently playing word being highlighted. During playback, when a word has become the target word, the user optionally and selectively can mark the word for review and possible correction during a subsequent correction session. Upon marking the word, the method of the invention can store position and length data associated with the marked word in an ordered list. During the subsequent correction session, the ordered list can be consulted to determine those words marked by the user.

Referring to claim 1, Applicants claim the steps of:

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sequentially highlighting individual words of said previously dictated text as each word is played in said audio representation;

selectively establishing marks during said playing of said audio representation for different ones of said sequentially highlighted words responsive to user commands, each said mark established when said word is highlighted; and,

storing said marks in an ordered list, each said mark including a current position and length of a corresponding marked word, said ordered list containing data associated only with marked words, whereby the marked words can be later recalled for correction in accordance with said ordered list.

The Examiner acknowledges that Mitchell does not teach "sequentially highlighting individual words of said previously dictated text as each word is played in said audio representation", and cites Edgar for this teaching, specifically citing FIGs. 17 and 18 of Edgar as well as the abstract.

Edgar, however, fails to provide the claimed teaching of sequentially highlighting individual words as each word is played. Instead, Edgar teaches a reading aid designed to only show one word or graphic at a time within a designated screen location. From FIG. 7, Edgar teaches "the process of reading to be undertaken in a manner that presents a single word onto a computer screen, and then replaces it with the following word in exactly the same position, eliminating motion of the eye between consecutive words." This teaching is distinct from and contradictory to, highlighting a word within a text document as the word is being read. Further, attempts to modify Edgar in the manner

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suggested (highlighting words instead of individually presenting them one at a time) would render Edgar unsatisfactory for its intended purpose, which is not permissible under MPEP 2143.01. Accordingly, it is improper to combine the teachings of Mitchell and Edgar as suggested.

The Examiner also acknowledges that Mitchell fails to teach the step of selectively establishing marks or step of storing the marks and relies upon Ballard for these teachings. Under §103(c) as noted above, however, Ballard cannot be used against the Applicants' claimed invention for purposes of a §103(a) rejection.

The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

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Respectfully submitted

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